

REMARKS

Claims 1-39 are pending in the present invention. Claims 1-39 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,963,939 issued to McCann et al. (hereinafter "McCann"). The Applicant traverses the outstanding rejections under 35 U.S.C. §102(b) and submits that claims 1-39 are in condition for allowance for at least the reasons presented herein. No new matter has been entered.

Rejections under §102(b)

Claims 1-39 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by McCann. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

The Examiner's rejection is respectfully traversed because each and every element as set forth in Applicant's Claim 1 is not found, either expressly or inherently described in McCann.

SOM920000011US1
123-0002
09/688,715

Claim 1 recites "A system for an adaptive sales interview search technique for an electronic catalog, the system comprising:

a customer interface;

a host system coupled to said customer interface through a network;

wherein said host system provides in said electronic catalog products contained in a database, provides in said electronic catalog questions relating to said products to be presented to a customer using said electronic catalog, supplies in said electronic catalog likely answers of the customer linked to constraints relative to said products contained in said database, selects said electronic catalog questions in order of a ranked importance, said ranked importance independent of any previous answers provided by said customer, presents a highest ranked question, receives an answer to said highest ranked question, applies said constraints based on said answer to said highest ranked question and limits product choices based on said answer to said highest ranked question; and a database coupled to said host system."

These limitations are not taught by McCann. Specifically, McCann does not teach or suggest selecting electronic catalog questions in order of a ranked importance which are independent of any previous answers provided by a customer. Nor does McCann teach presenting a highest ranked question, receiving an answer to the highest ranked question, and limiting product choices based on the answer to the highest ranked question. Rather, McCann teaches a method and system for assisting businesses in making purchasing decisions regarding their computer network needs. The method involves "gathering information on a user's computing equipment requirements through a series of questions and then suggests a solution that meets or exceeds those requirements" (Background; col. 2, lines 56-59). The method and system implement a Client Base

SOM920000011US1
123-0002
09/688,715

Class 120 “for each client and machine...defining a particular client’s determined configuration, so that a user can choose merely to update a current configuration rather than devise an entire new system...” (col. 7, lines 3-7; FIG. 22J). The Client Base Class 120 identifies a client during a login session (col. 7, lines 55-63; col. 8, lines 38-42) and specific client information is used by the method in determining a solution (col. 8, lines 43-46). Client information refers to information relating to a client’s existing computer system (col. 7, lines 20-30). Thus, McCann teaches that existing client computer systems are evaluated and factored into the solutions developed for a client. There is no teaching or requirement in Applicant’s Claim 1 that existing products are evaluated as part of the solution development process.

Further, in contrast to McCann, the Applicant’s Claim 1 teaches that questions “are selected in order of a ranked importance, said ranked importance independent of any previous answers provided by said customer.” Nothing in McCann teaches or suggests selecting and presenting questions in a ranked order of importance. The only ranking taught by McCann refers to product ranking, not question ranking. In support, McCann recites “[e]ach product known to the tool is assigned a rank...determined by comparing the product to other products on the market” (col. 4, lines 24-26). As further support, McCann recites “[s]ome of the general information is then translated into rankings. The rankings are based on the preferences defined by the user in response to the question block processes” (col 12, lines 2-5). Thus, McCann does not teach or suggest ranking questions as provided in Applicant’s Claim 1.

With respect to selecting and presenting questions in order of ranked importance, the Applicant submits that McCann, in fact, teaches away from Claim 1. The McCann reference teaches that a user may "control the entry of information by allowing the user to branch to other question blocks within the questions procedures" (col. 9, lines 36-38). Further support may be found in column 10, lines 42-49. By providing a user with control over the selection of questions, McCann teaches away from Claim 1 because Claim 1 recites that questions are ranked in order of importance and a highest ranked question is presented; a user, therefore, has no control over the presentment of questions.

Further, McCann teaches that a series of questions are presented to the user before the method calculates a solution (FIGs. 58A-58V and associated specification). Contrary to McCann, Applicant's Claim 1 recites that a highest ranked question is presented, a constraint is applied to an answer provided in response to the highest ranked question, and limited product choices based on the answer to the highest ranked question are determined. Thus, the evaluation process recited in Applicant's Claim 1 is implemented subsequent to receiving an answer to a particular question and not subsequent to a series of questions as taught by McCann.

Accordingly, because McCann does not teach each and every element of Applicant's Claim 1, the Applicant submits that Claim 1 is not anticipated by McCann. Reconsideration of the rejection is respectfully requested.

Claims 14 and 27 are believed to be allowable for at least the reasons given for Claim 1. Claims 2-13 depend from Claim 1, Claims 15-26 depend from Claim 14 and Claims 28-39 depend from Claim 27. Thus, these claims are believed to be allowable

SOM920000011US1
123-0002
09/688,715

due to their dependencies on Claims 1, 14 and 27. Accordingly, withdrawal of the claim rejections under 35 U.S.C. §102(b) is respectfully requested.

Conclusion

In view of the foregoing remarks, Applicant submits that this application is in condition for allowance. Early notification to this effect is requested.

If there are any charges due in connection with this response, please charge them to Deposit Account 06-1130 maintained by Applicant's Attorneys.

Respectfully submitted,

By: Marisa J. Dubuc

Marisa J. Dubuc
Registration No. 46,673
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 23413

Date: October 14, 2004

SOM920000011US1
123-0002
09/688,715

6